REMARKS

Claims 1-27 are pending in this application. For purposes of expedition, claims 1, 2, 8, 13, 14, 24, 26 and 27 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections, in accordance with current Office policy, to further define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

The disclosure has been objected to for reasons listed on page 2 of the Office Action (Paper No. 1). In response thereto, the disclosure has been amended to overcome the objection.

Claims 1-7 have been rejected under 35 U.S.C. §101 for reasons stated on pages 2-3 of the Office Action (Paper No. 1) dated on August 10, 2005. Specifically, the Examiner alleges that base claim 1 merely claims non-functional descriptive material recorded on a readable medium, which is not statutory under 35 U.S.C. §101. For purposes of expedition, base claim 1 has been amended to clearly define the functionality of each of the different types of information recorded on a recording medium. As a result, as amended, the rejection is deemed moot and should be withdrawn.

Claims 1 and 6 have been rejected under 35 U.S.C. §102(e) as being anticipated by Bruekers et al., U.S. Patent No. 6,320,825 for reasons stated on page 4 of the Office Action (Paper No. 1). Specifically, the Examiner asserts that Bruekers '825 discloses,

> "remake content based on at least one original content; (Col. 7 Line 55-57), original copyright information on the original content; (Col. 11 Line 47-50), remake copyright information on the remake content (Col. 11 Line 29-34)."

However, the Examiner's assertion is factually incorrect. Applicants submit that these features of Applicants' base claim 1 are not disclosed or suggested by Bruekers '825 in the manner suggested by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

Base claim 1 clearly defines a recording medium which comprises two types of information: (1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information on the original content, and (b) remake copyright information on the remake content, as shown in FIG. 4. This way the copyright of the original content can be advantageously protected, while the

personal use rights of an individual user on the original content can be guaranteed.

In contrast to Applicants' base claim 1, Bruekers '825 discloses a method, as shown in FIG. 4 and an apparatus, as shown in FIGs. 2-3, for recording audio information via a record carrier in which audio data is encoded (compressed) and the compressed audio data is recorded at a variable transfer speed in dependence upon the variable bit-rate so as to realize an effective information density.

Nevertheless, the Examiner cites column 7, lines 55-57 of Bruekers '825 for allegedly disclosing "remake content made based on at least one original content", column 11, lines 47-50 of Bruekers' 825 for allegedly disclosing "original copyright information based on the original content", and column 11, lines 29-34 of Bruekers '825 for disclosing "remake copyright information on the remake content." However, these citations are misplaced.

The cited column 7, lines 55-57 of Bruekers '825 only makes reference to data retrieval from a recording medium, which was previously compressed and recorded thereto, so that data retrieved can be de-compressed, via de-compressor 31, and decoded in order to reproduce the original audio data. In other words, audio data is compressed for recording and then decompressed for reproduction.

Similarly, the cited column 11, lines 47-50 of Bruekers' 825 simply refers to another type of information that can be compressed for recording on a recording medium, such as copyright information. Likewise, the column 11, lines 29-34 of Bruekers '825 discloses the use of a table of content (TOC) which contains the content information of a recording medium, including copyright information as compressed.

However, there is **no** disclosure from Bruekers '825 of Applicants' efforts to record on a recording medium: (1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information on the original content, and (b) remake copyright information on the remake content, as shown in FIG. 4, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in Applicants' base claim 1.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d

1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Bruekes '825 fails to disclose and suggest key features of Applicants' base claim 1 and its dependent claim 6. Therefore, Applicants respectfully request that the rejection of claims 1 and 6 be withdrawn.

Claims 24 and 25 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kaniwa et al., U.S. Patent No. 5,930,274 for reasons stated on pages 4-5 of the Office Action (Paper No. 1). While Applicants believe that Kaniwa '274 only discloses an information recording and reproduction apparatus in which a mechanism is utilized to protect the copyright of the original digital information transmitted and recorded by limiting the reproduction of recorded information, and does **not** make any reference to the "remake content" that is based on the original content and includes unique copyright information, in the manner as expressly defined in Applicants' base claim 24 and its dependent claim 25, base claim 24 has been amended to clearly establish the relationship between the "remake content" and the "original content" and the "original copyright information on the original content" and the "remake copyright information on the remake content" as shown in FIG. 4, in order to ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content. As amended, Applicants believe that the rejection is now moot and should be withdrawn.

Claim 27 has been rejected under 35 U.S.C. §102(b) as being anticipated by Fuchigami et al., U.S. Patent No. 5,960,398. Again, for purposes of expedition, base claim 27 has also been amended to establish the relationship between the "remake content" and the "original

content", and between the "original copyright information on the original content" and the "remake copyright information on the remake content" in order to clearly distinguish over Fuchigami '398 and to render the rejection moot. Fuchigami '398 only discloses a copyright information embedding system, as shown in FIG. 1, in which copyright information for copyright protection can be embedded into digital audio signal without deterioration of analog audio reproduced. As acknowledged on column 1, lines 44-48 of Fuchigami '398, conventional system used to embed copyright data into digital data has the drawback in that digital-to-analog (D/A) conversion of the digital data into analog audio data would cause reproduced sound quality to be deteriorated or changed uncomfortably. There is **no** disclosure from Fuchigami '398 of Applicants' efforts to reproduce from a recording medium: 1) remake content based on at least one original content, as shown in FIG. 1; and 2) copyright information, as shown in FIG. 1, that has both (a) original copyright information on the original content, and (b) remake copyright information on the remake content, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in Applicants' base claim 27. As a result, Applicants respectfully request that the rejection of base claim 27 be withdrawn.

Dependent claims 2, 3, 4, 5 and 7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bruekers et al., U.S. Patent No. 6,320,825, in view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons listed on pages 6-7 of the Office Action (Paper No. 1). In support of this rejection, the Examiner asserts that Bruekers '825, as a primary reference, discloses copyright information which includes a producer code and identification code, and that Fuchigami '398, as a secondary reference, discloses remake copyright information which includes a producer code (col. 5, line 51) of an apparatus used in making the remake content, and an identification code (col. 5, line 50) of the apparatus. Notwithstanding the reasons discussed against Bruekers '825 and Fuchigami '398, neither Bruekers '825 nor Fuchigami '398 discloses what the Examiner alleges. Specifically, Bruekers '825 only discloses a method and an apparatus for recording audio information via a record carrier in which audio data is encoded (compressed) and the compressed audio data is recorded at a variable transfer speed in dependence upon the variable bitrate so as to realize an effective information density. Bruekers '825 does **not** distinguish the difference between the "original content" and the "remake content" and the "original copyright information" and the "remake copyright information." As a secondary reference, Fuchigami '398 discloses a copyright information embedding system, as shown in

FIG. 1, in which copyright information for copyright protection can be embedded into digital audio signal without deterioration of analog audio reproduced. On column 5, lines 50-51 of Fuchigami '398, the original copyright data is recorded on a recording medium for copyright protection. There is **no** disclosure of any "remake copyright information" as alleged by the Examiner. More importantly, Fuchigami '398 does **not** remedy the noted deficiencies of Bruekers '825 in order to arrive at Applicants' claims 2, 3, 4, 5 and 7.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. Furthermore, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Bruekers '825 and Fuchigami '398 fail to disclose and suggest key features Applicants' claims 2, 3, 4, 5, and 7. Therefore, Applicants respectfully request that the rejection of claims 2, 3, 4, 5 and 7 be withdrawn.

Claims 8, 9 and 12-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Timis et al., U.S. Patent No. 5,792,971, in view of Bruekers et al., U.S. Patent No. 6,320,825 for reasons stated on pages 7-8 of the Office Action (Paper No. 1). In support of this rejection, the Examiner cites Bruekers '825 for allegedly disclosing, at column 11, lines 47-50, "original copyright information based on the original content", and at column 11, lines 29-34, "remake copyright information on the remake content." However, as previously discussed, the Examiner's assertion is factually incorrect. This is because the cited column 11, lines 47-50 of Bruekers' 825 simply refers to another type of information that can be compressed for recording on a recording medium, such as copyright information and, likewise, the column 11, lines 29-34 of Bruekers '825 discloses the use of a table of content (TOC) which contains the content information of a recording medium, including copyright information as compressed. There is **no** disclosure from Bruekers '825 of Applicants' efforts to record on a recording medium: 1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information,

as shown in FIG. 1, that has both (a) original copyright information on the original content, and (b) remake copyright information on the remake content, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in Applicants' base claim 8 and its dependent claims 9 and 12-13. In view of these reasons and reasons previously discussed, Applicants respectfully request that the rejection of claims 8, 9 and 12-13 be withdrawn.

Dependent claims 14 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Timis et al., U.S. Patent No. 5,792,971, and Bruekers et al., U.S. Patent No. 6,320,825, as applied to claims 8 and 13, and further in view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 9-10 of the Office Action (Paper No. 1). Since this rejection is predicated upon the correctness of the rejection of their base claim 8, Applicants respectfully traverse the rejection primarily based on the same reasons discussed against the rejection of their respective parent claim 8.

Claims 15, 16, 17, 21 and 24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kaniwa et al., U.S. Patent No. 5,930,274, in view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 10-11 of the Office Action (Paper No. 1). In support of this rejection, the Examiner asserts that Kaniwa '274, as a primary reference, discloses "a processor to generate copyright information including original copyright information on the original content and remake copyright information." The Examiner admits that Kaniwa '274 fails to disclose "copyright information including identification information relating to said apparatus on the remake content" but alleges that this feature is disclosed by Fuchigami '398.

However, as previously discussed, Kaniwa '274 only discloses an information recording and reproduction apparatus in which a mechanism is utilized to protect the copyright of the original digital information transmitted and recorded by limiting the reproduction of recorded information. There is **no** disclosure anywhere in Kaniwa '274 of Applicants' claimed "apparatus to record content on a recording medium" as expressly defined in base claim 15, as comprising:

> a converting unit to convert at least one original content into a remake content;
>
> a processor to generate copyright information including original copyright information on the original content and remake copyright information including identification information relating to said apparatus on the remake content; and
>
> a recording unit to record the remake content obtained by the converting unit, the identification information and the copyright information generated by the processor on a recording medium.

As a secondary reference, Fuchigami '398 only discloses a copyright information embedding system, as shown in FIG. 1, in which copyright information for copyright protection can be embedded into digital audio signal without deterioration of analog audio reproduced. Specifically, on column 5, lines 50-51, Fuchigami '398 discloses that the original copyright data is recorded on a recording medium for copyright protection. Fuchigami '398 does **not** disclose or suggest any "remake copyright information" as alleged by the Examiner, and certainly, does **not** remedy the noted deficiencies of Kaniwa '274 in order to arrive at Applicants' base claim 15 and its dependent claims 16, 17, 21 and 24.

In view of these reasons and the noted deficiencies of Kaniwa '274 and Fuchigami '398, Applicants respectfully request that the rejection of claims 15, 16, 17, 21 and 24 be withdrawn.

Lastly, dependent claims 18 and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kaniwa et al., U.S. Patent No. 5,930,274, and Fuchigami et al., U.S. Patent No. 5,960,398, as applied to claim 17 above, and further in view of Bruekers et al., U.S. Patent No. 6,320,825 for reasons stated on pages 11-12 of the Office Action (Paper No. 1). Lastly, dependent claim 11 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Timis et al., U.S. Patent No. 5,792,971, and Bruekers et al., U.S. Patent No. 6,320,825, as applied to claim 8 above and further in view of Ando et al., U.S. Patent No. 6,308,005 for reasons stated on pages 13-14 of the Office Action (Paper No. 1). Since these rejections are predicated upon the correctness of the rejection of their respective parent claims, Applicants respectfully traverse these rejections primarily based on the same reasons discussed against the rejection of their respective parent claims.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext: 232. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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